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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,283	12/09/2003	Jesse G. James	48-1007	2593

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EXAMINER

KRAMER, DEVON C

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,283

Applicant(s)

JAMES, JESSE G.

Examiner

Devon C Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Specification

- 1) The disclosure is objected to because of the following informalities:

Page 5 paragraph 38 line 4, please add the missing information including application number 10/730282 with a filing date of 12/9/03.

Appropriate correction is required.

Claim Objections

- 2) Claims 11-12 are objected to because of the following informalities:

Claim 11, "the disk" should be --a disk--;

Claim 11, "the axis of rotation" should be --an axis of rotation--;

Claim 12, "the weight" should be --a weight--;

Claim 12 line 2, "the front suspension and rear suspension" should be --a front suspension and rear suspension--;

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 4) Claims 3 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 3 cites, "wherein the disk axis is spaced from the rear axle." This statement is confusing because the disk axis intersects the rear axle. For examination purposes the claim has been read as the disk spaced from the rear axle.

Claim 20 claims that the rear wheel axis and disk axis are spaced from each other. This statement is unclear because they intersect each other at a right angle or close to a right angle.

Claim Rejections - 35 USC § 102

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6) Claims 1-11, 13-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe (4719984), with further clarification by Wilcox (5590998) under MPEP 2131.01 section II.

In re claim 1, Watanabe teaches a motorcycle (figures 1 and 2) having a longitudinal axis extending from a front wheel (15) to a rear wheel (21), the rear wheel having an axis of rotation, the motorcycle also including a braking system (figure 5), the braking system comprising: a disk (64) having a disk axis and a first side disposed proximate an output of a gearbox (29), wherein the disk rotates about the disk axis; the disk having a second side opposite the first side, a universal joint (42) being attached to the second side of the disk; and wherein the disk axis is different than the axis of rotation of the rear wheel.

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Wilcox is used to teach that four wheeled vehicles are motorcycles. (Abstract)

In re claim 2, see figure 2 of Watanabe.

In re claim 3, see elements 68 and 59 of Watanabe.

In re claim 4, see figures 1 and 2.

In re claim 5, since the engine is considered sprung weight and the brake is attached to the driveshaft which in turn is attached to the engine, the disk can be considered as sprung weight. Further, since Watanabe is silent to a suspension, the disk can be a sprung by the resiliency of the tires.

In re claim 6, see 33 and 42 of figure 4.

In re claim 7, Watanabe teaches a motorcycle comprising: a front wheel (15) with a front axle; a rear wheel (21) with a rear axle; and a brake system (figure 1) disposed between the front axle and the rear axle, wherein the brake system qualifies as sprung weight. Further, since Watanabe is silent to a suspension, the disk can be a sprung by the resiliency of the tires.

In re claims 8 and 19, see element 64 and 58.

In re claim 9, see figure 4 elements 33 and 64.

In re claim 10, see figure 4 element 42 and 43.

In re claim 11, see figures 1 and 2.

In re claim 13, the rear brake assembly of Watanabe qualifies as sprung weight.

IN re claim 14, the rear brake assembly includes a disk (64) and caliper (73).

In re claim 15, see element 67.

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In re claim 16, Watanabe teaches a motorcycle comprising: a front wheel (15) with a front axle; a rear wheel (21) with a rear axle; the motorcycle having a body perimeter, and a disk adapted to brake the rear wheel located within the body perimeter. See figures 1-2.

In re claim 17, see figures 1-2 elements 12, 18 and 19.

In re claim 20, the rear axle and disk of Watanabe are spaced.

Claim Rejections - 35 USC § 103

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claim 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (4719984) in view of Suzuki (2003/0029665).

Watanabe is silent to a suspension.

Suzuki teaches a similar motorcycle to that of Watanabe with a suspension.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the motorcycle of Watanabe with a suspension like that taught by Suzuki in order to protect the vehicles occupants and parts from shock. Please note that the motorcycle of Watanabe as modified by Suzuki would have a suspension system supporting the disk.

9) Claim 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (4719984) in view of Maeda et al (2004/0140146).

Watanabe is silent to a suspension system.

Maeda et al teaches a rear wheel mounted on a swing arm assembly that pivots.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the motorcycle of Watanabe with the suspension as taught by Maeda et al merely to provide a comfortable ride to a driver, and to protect the motorcycle components and driver. Please note that the motorcycle of Watanabe as modified by Maeda et al would have a swing arm that would pivot with respect to the disk.

Conclusion

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Takimoto, Martins and Matsuura et al all provide braking devices with similar features to the instant application.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 703-305-0839. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DK

Deon
8/30/04